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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
| 10/018,609 | 02/11/2002 | Ernst Rytz | 01-732 | 5092 |
| 7590 Bachman & LaPointe Suite 1201 900 Chapel Street New Haven, CT 06510-2802 | | 08/19/2008 | EXAMINER MICHALSKI, SEAN M | |
| | | | ART UNIT 3724 | PAPER NUMBER PAPER |
| | | | MAIL DATE 08/19/2008 | DELIVERY MODE PAPER |

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/018,609

Filing Date: February 11, 2002

Appellant(s): RYTZ ET AL.

Ross J. Christie
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 6/25/2008 appealing from the Office action
mailed 10/24/2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

| | | |
|-----------|-----------|--------|
| 3,570,343 | Wolnosky | 3-1971 |
| 4,905,556 | Haack | 3-1990 |
| 6,240,818 | Baltschun | 6-2001 |

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-3, 7, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolnosky (3,570,343) in view of Haack et al (4,905,556).

Wolnosky discloses the invention as claimed including a press plate (34) having a V-ring cylinder (42), which is under pressure from a V-ring cylinder (88) comprising a V-ring piston rod connected to a V-ring piston (86) disposed opposite to and in support of the V-ring (42) of the press plate (34), and a blanking punch (54) which is guided in the press plate (34) and to which a die plate (24) with counter holder is assigned at a ram, wherein the ram is supported against at least one compensation cylinder (66/68) and against at least one main cylinder (58). In addition, Wolnosky discloses a hydraulic connection (64/90) comprising a tank (72, 92) and logic valve (82, 94).

Wolnosky fails to disclose the compensation cylinders are hydraulically connected to the V-ring cylinder. However, Haack et al discloses an apparatus for blanking wherein cylinders from the upper and lower die shoes are connected hydraulically. This connection eliminates the need for several tanks while still allowing for individualized control of the different sections with separate valves. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the cylinders of the Wolnosky device hydraulically connected, as disclosed by Haack et al, for the purpose of eliminating a tank, thus reducing cost and complexity.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wolnosky in view of Haack et al as applied to claims 1 and 3 above, and further in view of Baltschun (6,240,818).

The Wolnosky-Haack combination fails to expressly disclose the cross-sectional area of the compensation pistons and V-ring pistons as claimed. However, Baltschun teaches the importance of equal piston areas of opposed cylinders in a blanking device in order to achieve an equilibrium state. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the pistons of the Wolnosky-Haack combination equal in cross-sectional area, as disclosed by Baltschun, for the purpose of creating an equilibrium state.

(10) Response to Argument

At page 6 of the Appeal Brief appellant argues that in order to meet the test for obviousness, the examiner must determine whether the prior art would have "suggested to those of ordinary skill in the art that they should make the claimed composition or device". This is an unduly narrow construction of 35 U.S.C. § 103, and current obviousness jurisprudence. The Supreme Court in *KSR International Co. v. Teleflex Inc. et al.* No. 04-1350, 550 U.S. ____ (2007), 82 USPQ2d at 1396, foreclosed the argument that a specific teaching, **suggestion** or motivation is required to support a showing of obviousness. See the Board decision *Ex parte Smith* –USPQ2d--, slip op at 20, (Bd. Pat. App. & interf. June 25, 2007). Rather the totality of evidence including inferences that one of ordinary skill could have made at the time of the invention colors the obviousness inquiry. Appellant has not set forth appropriate evidence of secondary

considerations, or sufficiently rebutted the *prima facie* case of obviousness present in the case (as by clear and convincing evidence), and therefore the obviousness of the claims is submitted to the Board for appropriate review, in accordance with the appropriate, flexible, obviousness inquiry.

At page 7, appellant argues that "Appellants' compensation cylinders do not work together with piercing pads as taught by Wolnosky and thus are structurally different and do not necessarily operate in the same manner as Wolnosky's apparatus". Even conceding the truth of the matter asserted, this is irrelevant to the question of whether Wolnosky meets the claim limitations. Since "compensation cylinder" has no special definition, it must be construed as broadly as is reasonable. There is no limitation in the claims as submitted that requires a "compensation cylinder" **not** work with piercing pads. This argument is not persuasive to overcome the *prima facie* case of obviousness now in the record.

At page 8, Appellant alleges that "the examiner has also not identified a single source of common knowledge..." This is incorrect, both in essence and in particular. Examiner has not conceded that Wolnosky and Haack lack a motivation, but that they lack *explicit* motivation. Examiner has in no way based the motivation for combination on the disclosure or claims of appellant. Examiner specifically and clearly set forth that the motivation to combine was "for the purpose of eliminating a tank, thus reducing cost and complexity". The motivation to use the different elements (all of which are **known** in the art) together was that doing so would reduce the cost and complexity of the device. One of ordinary skill would have saved money by using one valve instead of multiple

valves, which is a valid reason to modify the references in the ways disclosed above (there are additional reasons and rationales-readily identified by one of ordinary skill). Appellant has presented no **evidence** that one of ordinary skill in the art would have **been unable to effect the desired combination**, each of the elements being known in the prior art and unchanged in function in the present combination.

Appellant also fails to appreciate the level of ordinary skill in the art, which is that of a designer of such systems as the presently claimed apparatus. Such a theoretical person would be capable of rearranging parts, and making necessary substitutions to effect a wide variety of measures, including measures *chosen as a matter of design choice* to lower cost, weight, operating cost, assembly steps (DFA), ease of maintenance (DFM) or other parameters as dictated by the problem itself (punching).

On page 9, Appellant alleges that one of ordinary skill, in seeking to use a hydraulic connection with a single logic valve, would be unable to do so, and would only be able to construct an inoperable press. This allegation is without sufficient evidentiary support to overcome the *prima facie* case of obviousness, as set forth above.

At page 13, Appellant alleges that Baltschun does not teach the use of a compensation cylinder, as required by independent claim 1. As has been discussed above, Wolnosky teaches the use of a compensation cylinder, in accordance with the claims, terms in a claim being given their broadest reasonable interpretation. The standard of claim interpretation during prosecution is as follows: "claims in a pending application should be given their broadest reasonable interpretation" consistent with the specification and prior art. In re Pearson , 181 USPQ 641 (CCPA 1974). See

additionally MPEP 904.01, and also *In re Morris*, 127 F.3d 1048, 44 USPQ2d 1023 (Fed. Cir. 1997). It has been established that during examination, where Appellant has the ability to amend claims, the standard of claim interpretation is that the broadest reasonable interpretation be given to all the terms of a claim, *absent a specific definition provided in the specification*, which would then control.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Sean M Michalski/

Examiner, Art Unit 3724

Conferees:

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Supervisory Patent Examiner, Art Unit 3724 TQAS TC3700

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